

## **REMARKS**

The present amendment is in response to the Rejection dated November 23, 2005, where the Examiner rejected claims 1-20. The Examiner provided a Claim Objection because of an informality, which the Applicant has addressed herewith. Additionally, the Examiner provided claim rejection under 35 USC 103.

### **A. Specification**

The Examiner identified some minor typographical errors and the Applicant has provided replacement paragraphs that reflect these changes.

### **B. Claim Objections**

The Examiner objected to each independent claim and recommended that “insulators” be changed to “insulator modules.” As requested by the Examiner, the Applicant has corrected the informality and changed the wording.

### **C. Claim Rejection Under 35 USC 103**

The Examiner rejected claims 1-20 as unpatentable over Burden, U.S. Patent 3,243,568 (“Burden ‘568”) in view of Wada et al., U.S. Patent No. 4,208,564 (“Wada ‘564”), and further in view of Saito et. al, Japanese Patent 3-297587 (“Saito ‘587”). Applicant respectfully disagrees with the Examiner’s arguments.

As stated in Section 2143 of the MPEP:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a

reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. Section 2143, MPEP Rev. 2.0, May 2004, pg. 2100-129.

The Applicant's independent claims 1, 9, and 13 each include the limitation that "said plurality of insulator modules are disposed along said length of said first elongated strip and said second elongated strip." As stated above, to establish a prima facie case obviousness rejection, the Examiner's prior art must teach or suggest all claim limitations.

As stated by the Examiner, Burden '568 does **not** disclose a plurality of insulator modules. Additionally, Wada '564 does teach a plurality of insulator modules, but does **not** teach a consumable guide tube having insulator modules disposed along the length of the first and second elongated strip. Furthermore, Saito '587 does **not** teach a plurality of insulator modules coupled to elongated strips and does **not** teach insulator modules disposed along the length of the first and second elongated strip. Since, none of the prior art references cited by the Examiner teach each and every limitation, the Applicant respectfully submits that the Examiner has failed to meet the prima facie obviousness requirements.

However, the Examiner cites Wada '564 and Burden '568 and argues that it would have been obvious to one of ordinary skill in the art to add a plurality of insulator modules to prevent a short circuit. See Page 4 of the Office Action. Firstly, Applicant respectfully submits the Examiner's arguments are flawed because the Examiner does NOT address the location of the plurality of insulator modules. In fact, the Examiner provides no objective reason for the limitation "wherein the

plurality of insulator modules are *disposed along the length of said first elongated strip and said second elongated strip.*"

For argument purposes only and to expedite the prosecution of this patent application, if the Applicant assumes that the Examiner was arguing that the location of the plurality of insulator modules along the elongated strip was obvious to prevent a short circuit, then it is interesting to note that the Examiner's next reference makes no reference to short circuiting. In fact, Saito '587 states the purpose of the invention is to "... prevent swing of consumable nozzle at the time of welding ... prior to swing of the consumable nozzle 24, anyone of four projections 44 ... is brought into contact with base material 10." The objective goal is Saito '587 is to **accurately position** the consumable nozzle, and not to avoid short circuiting. Therefore, Applicant argues that it would NOT have been obvious to one in ordinary skill in the art to provide plurality of insulator modules that are *disposed along the length of said first elongated strip and said second elongated strip*

The Examiner then proceeds to argue that it would have been obvious to take Burden (which teaches a consumable guide tube having elongated strips), add Wada (which teaches a plurality of insulator modules), add ordinary skill in the art (to have a plurality of insulator modules to prevent short circuiting), and add Saito (which teaches an insulator module that melts into the a molten flux puddle). The Applicant respectfully disagrees.

Again as previously stated, each and every element of the claimed invention must be taught by the prior art. Here, the prior art does not teach *inter alia* elongated strips having a plurality of insulator modules disposed along the length of the strips. Additionally, what the Examiner once argued as obvious to one with

ordinary skill in the art is no longer obvious because the Saito reference teaches away from the Examiner's ordinary skill in the art language.


The Applicant contends that the independent claims 1, 9 and 13 are in a state of allowance. Therefore, each of the claims that depend on claims 1, 9 and 13 are also in a state of allowance.

**D. Conclusion**

For all the foregoing reasons, the Applicant requests allowance of claims 1-20 in the present application.

Respectfully Submitted;

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